

REMARKS

Reconsideration of this application is respectfully requested in light of the above amendments and the following remarks. After the amendments detailed above, claims 1-5, 7-12 and 14-34 are pending in this application. In particular, claims 1, 4, 9, 15, 19, 22, 26 and 31 have been amended and claims 2, 3, 5, 7, 8, 10-12, 14, 16-18, 20, 21, 23-25, 27-30 and 32-34 have been maintained in their previous form. Claims 6 and 13 remain canceled. No new claims are added. Applicant asserts that the amended claims are fully supported by the disclosure of the application as filed, and as such, do not introduce new matter. The status of all the pending claims is reflected in the above listing.

I. 35 U.S.C. § 112

Claims 1-5, 7-12, 14 and 19-30

The Examiner has rejected claims 1-5, 7-12, 14 and 19-30 under 35 U.S.C. § 112 as being indefinite. Applicant has amended claims 1, 9, 19 and 26 to clearly define that the claimed subject matter is necessarily attached to a human finger or thumb. Accordingly, these rejections should be withdrawn.

II. 35 U.S.C. § 102

Claims 1, 2, 4, 8-10 and 15-17

Claims 1, 2, 4, 8-10 and 15-17 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,653,524 to Gray. These rejections are moot as claims 1, 9 and 15 have been amended.

To anticipate a claim, the cited reference must disclose each and every limitation recited in the subject claim. "Anticipation requires the disclosure in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). As set forth below, Gray fails to disclose, expressly or inherently, at least one element recited in each of the amended claims.

As illustrated in the figures and described in the specification, a lighting device 100 comprises an elastic band 130 for attaching the lighting device 100 to a user's thumb or

finger, and a button 160 for activating a light source contained within a housing 110 of the lighting device 100 (pages 3-4, paragraphs [0015] and [0017], and figures 1 and 2). The button 160 for activating the light source extends from the bottom of the housing 110 and makes contact with non-tip portions of the user's thumb or finger when the user is wearing the lighting device on his or her thumb or finger (figure 1).

Accordingly, the present claims are patentably distinct as written, and the rejection of these claims under Section 102 must be withdrawn. Specifically, claims 1 and 9 have been amended to further recite "... a button extending from a bottom portion of the housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached ..." while claim 15 has been amended to further recite "... applying intermittent pressure to a button extending from a bottom portion of a housing such that the button is in contact with a non-tip portion of the fingers or thumbs on which the one or more lighting devices are attached ..."

Gray, in contrast, fails to disclose a lighting device having a button extending from a bottom portion of a housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached. The illuminated ring of Gray comprises a pole switch 52 or a throw switch 56 for activating the light emitting diodes 44, 46, 54 located within a light housing 30 (col. 4, lines 47 – col. 5, lines 12 and figures 2, 5 and 6). As illustrated in figure 2, the pole switch 52 is situated at the side of the illuminated ring. When a user is wearing the illuminated ring on a thumb or finger via an annular ring 12, the pole switch 52 does not make contact with a non-tip portion of the thumb or finger because the pole switch 52 outside of the illuminated ring. Consequently, the activation button in Gray does not extend from a bottom portion of a housing nor does it make contact with a non-tip portion of the human thumb or finger. Accordingly, Gray fails to disclose, explicitly or inherently, at least one element recited in each of amended independent claims 1, 9 and 15.

Since Gray fails to expressly or inherently disclose each element in claims 1, 9 and 15, and since claims 2, 4, 8, 10, 16 and 17 depend from and further limit claims 1, 9 and 15, the rejection of these claims is also overcome. Claim 4 has been amended for antecedent issues and not for reasons related to patentability. Therefore, claims 1, 2, 4, 8-10 and 15-17 are patentably distinct as written, and the rejection of these claims under

Section 102 should accordingly be withdrawn.

Claims 19, 20, 22, 25-27 and 31-33

Claims 19, 20, 22, 25-27 and 31-33 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,622,062 to Gong-Hwa. These rejections are moot as claims 19, 26 and 31 have been amended.

To anticipate a claim, the cited reference must disclose each and every limitation recited in the subject claim. "Anticipation requires the disclosure in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Id.* As set forth below, Gong-Hwa fails to disclose, expressly or inherently, at least one element recited in each of the amended claims.

Accordingly, the present claims are patentably distinct as written, and the rejection of these claims under Section 102 must be withdrawn. Specifically, claims 19 and 26 have been amended to further recite "... a button extending from a bottom portion of the housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached ..." while claim 31 has been amended to further recite "... applying intermittent pressure to a button extending from a bottom portion of a housing such that the button is in contact with a non-tip portion of the fingers or thumbs on which the one or more lighting devices are attached ..." The amended claims are fully supported by the disclosure of the application as filed. See discussion supra.

Like Gray, Gong-Hwa also fails to disclose a lighting device having a button extending from a bottom portion of a housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached. The sound and light-producing ring of Gong-Hwa comprises a cap 20, which triggers a spring switch 34 whereby LEDs 300 are activated to produce a lighting effect and a buzzer 35 is activated to produce a sounding effect (col. 2, lines 26-35 and figure 2). When a user is wearing the sound and light-producing ring on a thumb or finger via a circular band 11, the cap 20 or triggering switch 34 for activating the LEDs 300 do not make contact with a non-tip portion of the thumb or finger because the activating mechanism 34 is completely enclosed within through holes 15 and the cap 20 (figures 1 and 2). Furthermore, the cap 20 is situated at the top of the illuminated ring away from a user's thumb or finger when the user is wearing

such device on the thumb or finger (figures 1 and 2). Consequently, the activation button in Gong-Hwa does not extend from a bottom portion of a housing nor does it make contact with a non-tip portion of the human thumb or finger. Accordingly, Gong-Hwa fails to disclose, explicitly or inherently, at least one element recited in each of amended independent claims 19, 26 and 31.

Since Gong-Hwa fails to expressly or inherently disclose each element in claims 19, 26 and 31, and since claims 20, 22, 25, 27, 32 and 33 depend from and further limit claims 19, 26 and 31, the rejection of these claims is also overcome. Claim 22 has been amended for antecedent issues and not for reasons related to patentability. Therefore, claims 19, 20, 22, 25-27 and 31-33 are patentably distinct as written, and the rejection of these claims under Section 102 should accordingly be withdrawn.

III. 35 U.S.C. § 103

Claims 3, 7, 11, 14 and 18

Claims 3, 7, 11, 14 and 18 were rejected under U.S.C. § 103(a) as being unpatentable over Gray. These rejection are moot as claims 1, 9 and 15 have been amended.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” MPEP 2143.03. Claims 3, 7, 11, 14 and 18 depend from and further limit amended independent claims 1, 9 and 15, which have been amended to further recite “... a button extending from a bottom portion of the housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached ...” and “... applying intermittent pressure to a button extending from a bottom portion of a housing such that the button is in contact with a non-tip portion of the fingers or thumbs on which the one or more lighting devices are attached ...” Gray does not disclose or teach all of the limitations in amended independent claims 1, 9 and 15 by the same arguments above. The arguments made above with respect to amended independent claims 1, 9 and 15 regarding the applicability of Gray apply with equal force here. See discussion *supra*.

Gray fails to expressly or inherently disclose at least one element of dependent claims 3, 7, 11, 14 and 18, which depend from and further limit amended independent

claims 1, 9 and 15, namely, Gray fails to disclose a lighting device having a button extending from a bottom portion of a housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached. See discussion supra. Since all the claim limitations have not been taught or suggested by Gray, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met. In re Royka. Accordingly, claims 3, 7, 11, 14 and 18 are not obvious under Section 103 and the rejection of these claim should be withdrawn.

Claims 5 and 12

The Examiner has rejected claims 5 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Gray in view of Dion (U.S. Patent No. 5,934,784). These rejection are moot as claims 1 and 9 have been amended. Furthermore, applicant respectfully asserts that claims 5 and 12 are not obvious over Gray in view of Dion because there is no motivation to combine Gray with Dion to provide a lighting device having a button extending from a bottom portion of a housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." MPEP 2143.03. Claims 5 and 12 depend from and further limit amended independent claims 1 and 9, which have been amended to further recite "... a button extending from a bottom portion of the housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached ..." Gray does not disclose or teach all of the limitations in amended independent claims 1 and 9 by the same arguments above. The arguments made above with respect to amended independent claims 1 and 9 regarding the applicability of Gray apply with equal force here. See discussion supra.

Furthermore, the Examiner's burden of factually supporting a *prima facie* case of

obviousness has not been met because there is no motivation in Gray to provide a lighting device having a button extending from a bottom portion of a housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached. Accordingly, there is no suggestion or motivation to combine Gray with Dion and the rejection of claims 5 and 12 under Section 103 should be withdrawn.

Claims 21, 23, 24, 28-30 and 34

Claims 21, 23, 24, 28-30 and 34 were rejected under U.S.C. § 103(a) as being unpatentable over Gong-Hwa. These rejections are moot as claims 19, 26 and 31 have been amended.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." MPEP 2143.03. Claims 21, 23, 24, 28-30 and 34 depend from and further limit amended independent claims 19, 26 and 31, which have been amended to further recite "... a button extending from a bottom portion of the housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached ..." and "... applying intermittent pressure to a button extending from a bottom portion of a housing such that the button is in contact with a non-tip portion of the fingers or thumbs on which the one or more lighting devices are attached ..." Gong-Hwa does not disclose or teach all of the limitations in amended independent claims 19, 26 and 31 by the same arguments above. The arguments made above with respect to amended independent claims 19, 26 and 31 regarding the applicability of Gong-Hwa apply with equal force here. See discussion supra.

Gong-Hwa fails to expressly or inherently disclose at least one element of dependent claims 21, 23, 24, 28-30 and 34, which depend from and further limit amended independent claims 19, 26 and 31, namely, Gong-Hwa fails to disclose a lighting device having a button extending from a bottom portion of a housing such that the button is in contact with a non-tip portion of a human finger or thumb on which the device is attached. Since all the claim limitations have not been taught or suggested by Gong-Hwa, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met. In re Royka. Accordingly, claims 21, 23, 24, 28-30 and 34 are not obvious

under Section 103 and the rejection of these claim should be withdrawn.

IV. Conclusion

It is respectfully submitted that the application is now in condition for allowance and, accordingly, reconsideration and allowance are respectfully requested. Should any questions remain regarding the allowability of the application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

Greenberg Traurig
3773 Howard Hughes Pkwy.
Suite 500 North
Las Vegas, Nevada 89109

Telephone : 702-792-3773
Facsimile : 702 792-9002

By:


Rob L. Phillips
Registration No. 40,305

Date: April 24, 2006

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of fees which may be required by this paper to Deposit Account No. 502466 including any fee for extension of time, or the fee for additional claims which may be required. Please show our docket number with any Deposit Account transaction. A copy of this letter is enclosed.